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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,474	07/07/2003	Kurt M. Hickey	9314-34	9329

20792 7590 06/07/2005
MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

EXAMINER

CUMMING, WILLIAM D

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,474

Applicant(s)

HICKEY & ECKHOLM

Examiner

WILLIAM D CUMMING

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the remote communication device as stated by claim 10; the remote wireless communications device as stated by claim 11; and the least one of the first and second user interface devices is releasably connected to the second housing as stated by claim 16 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The use of the trademark BLUETOOTH has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

4. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 10-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification inadequately describe the the remote communication device as stated by claim 10; the remote wireless communications device as stated by claim 11; and the least one of the first and second user interface devices is releasably connected to the second housing as stated by claim 16. The "*written description*" of the invention required by first paragraph of 35 USC §112 is separate and distinct from that paragraph's requirement of enabling disclosure, since description must do more than merely provide explanation of how to "*make and use*" the invention. Applicant must also convey, with reasonable clarity to those skilled in the art, that applicant, as of the filing date sought, was in possession of the invention, with the invention being, for purpose of "*written description*" inquiry, whatever is presently claimed. Drawings alone may, under proper circumstances, provide "*written description*" of the invention required by 35 USC §112, and whether the drawings are from design application or utility application is not determinative. In order to satisfy "*written description*" requirement of 35 USC §112, the proper test is whether drawings conveys, with reasonable clarity to those of ordinary skill in the art, the claim subject matter.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-11, 13, 14, 17, and 18 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Janninck, et al (*birth patents*).

A mobile computing device (figures 1 & 2) comprising a first housing; (#120) computing circuitry within the first housing (*"Referring to FIG. 5, the electronic components 500 of the radiotelephone 100 are housed within the upper and lower housings 120 & 220. The electronic components 500 include a processor 510, a transceiver 520 and an antenna 530. For the preferred embodiment, the antenna 530 transmits radio frequency ("RF") signals received from the transceiver 520 and provides RF signals to the transceiver that it receives. Likewise, the transceiver 520 converts controls signals received from the processor 510 for transmission by the antenna 530, and converts RF signal received by the antenna for processing by the processor. The processor 510 acts as a central processing unit for the radiotelephone 100 and coordinates the operations of the electronic components 500. The processor 510 also includes a memory portion 512 to store and retrieve data as well as perform various*

operations of the radiotelephone 100. However, it is to be understood that various functions described herein for the electronic components 500 may be integrated or segregated and, thus, the present invention is not limited to particular discrete components shown in FIG. 5. For example, the processor 510 and the transceiver 520 may be combined in a single integrated circuit, or the processor and the memory portion 512 may be separated to different components"). A display (#150) that is configured to visually display information from the computing circuitry (figure 5) to a user, wherein the display (#150) is at least partially disposed within the first housing (#120). A second housing (#230) that is rotationally coupled to the first housing (#120); a first user interface device (#232) that is at least partially disposed within the second housing (#230) and a second user interface device (#234) that is at least partially disposed within the second housing (#230), and wherein the second housing (#230) is configured to be rotated relative to the first housing (#120) between a closed position in which the first and second user interface devices (#232, 234) are at least partially covered by the first housing (#120) and a deployed position (#260, 210, 270) in which the first and second user interface devices (#232, 234) are at least partially uncovered on opposite lateral sides of the first housing (#120).

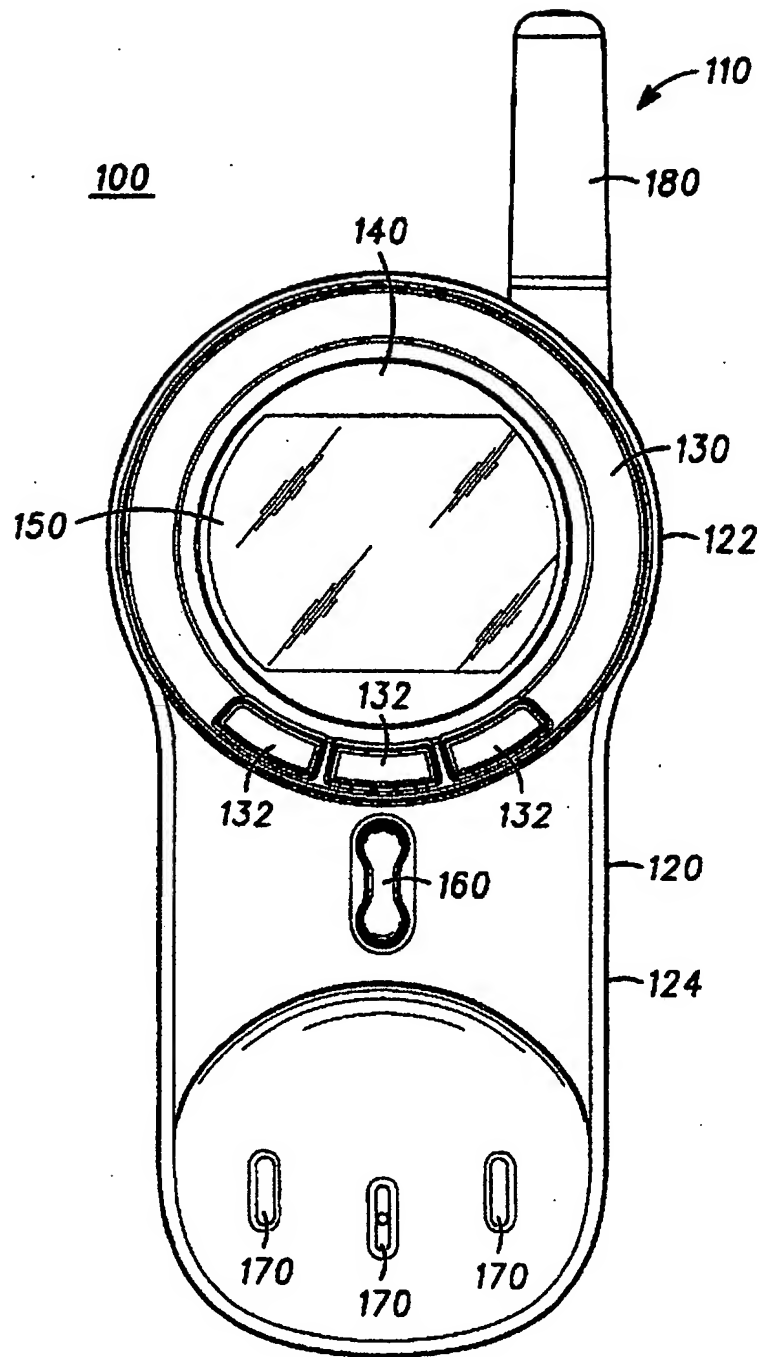


FIG. 1

Regarding claim 7, *"The preferred embodiment includes a standard layout of alphanumeric and menu control for operation of the radiotelephone 100. As shown in FIG. 2, the keypad 230 includes twelve standard keys 232 (namely, 0 through 9, # and *) as well as three lower housing selection buttons 234. However, the radiotelephone 100 may include a larger grouping of keys, such as a QWERTY keyboard, if a device having a larger form factor or smaller individual keys is desired. Although not shown in FIG. 2, the keypad 230 may also include a cursor or graphical pointing device such as a joystick, touch pad or track ball. Also, similar to selection buttons 132 and 160 described, above, the lower housing selection buttons 234 may be used for various features including, but not limited to, volume control, menu control, call answering, call termination, caller identification, phone book control, voicemail control, e-mail/messaging control, network browsing, power on/off, and the like."*

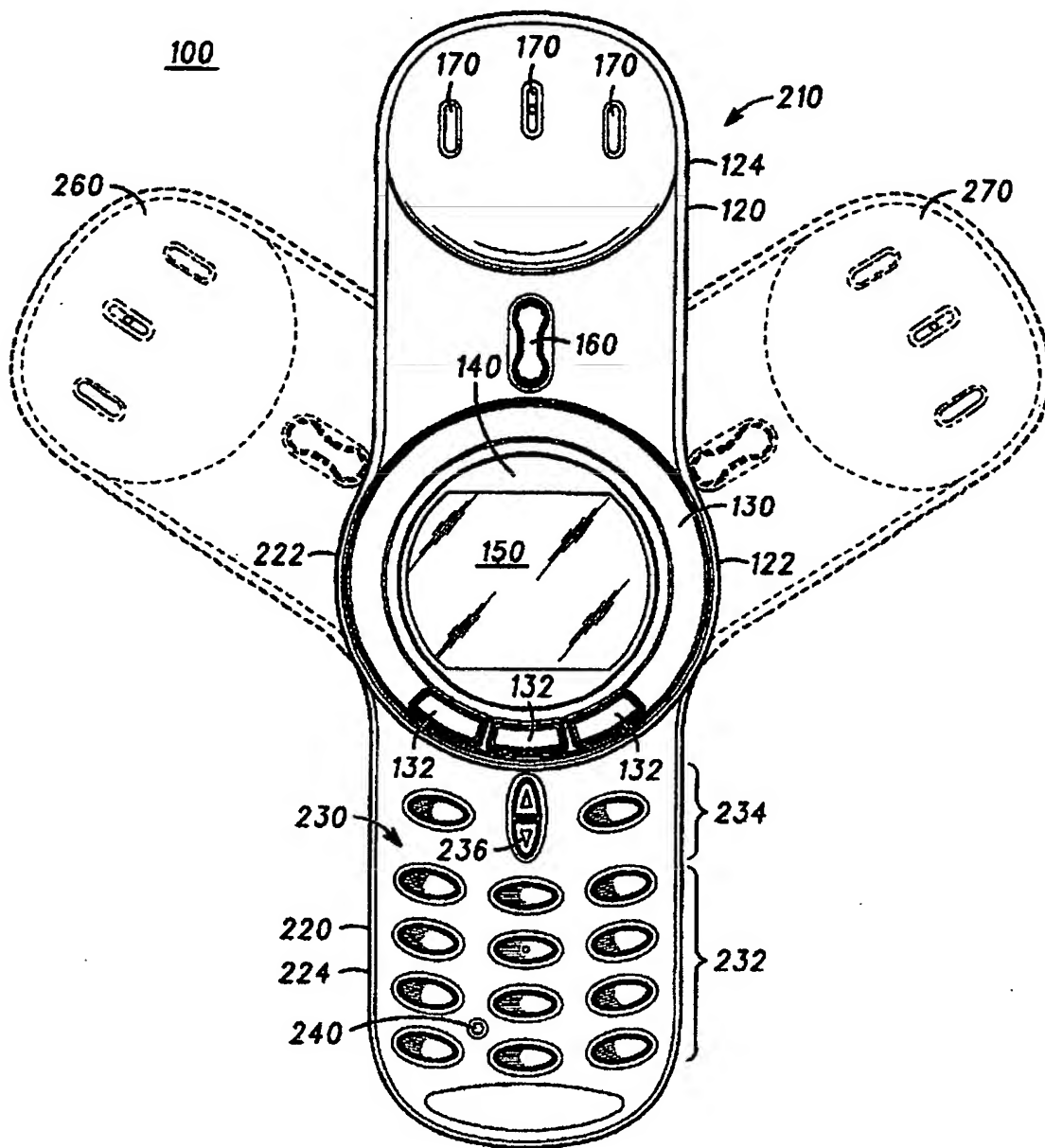
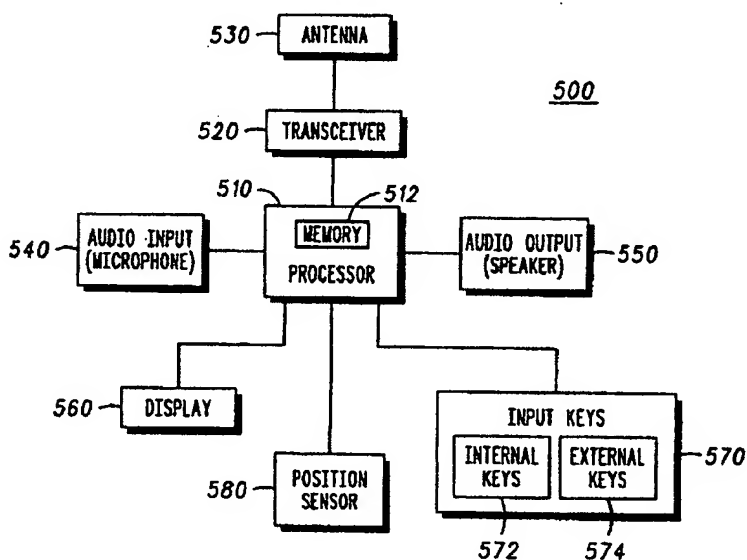


FIG. 2

Regarding claim 13, *"The extended portion 124 of the upper housing 120 may include upper housing selection buttons 160 and speaker apertures 170. Although many different selection buttons may be provided on the upper housing 120, only one upper housing selection button 160 is shown in FIG. 1 by way of example. Thus, the upper housing 120 of the present invention may include one or more selection buttons (such as selection buttons 132 and 160) for various types of features including, but not limited to, volume control, menu control, call answering, call termination, caller identification, phone book control, voicemail control, e-mail/messaging control, network browsing, power on/off, and the like. The speaker apertures 170 direct sounds generated by an audio output device (shown in FIG. 5) to the user."*

**FIG. 5**

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Janninck, et al.** and application admission of the prior art.

Applicants admit that games are integrated into mobile terminals is prior art in page 1 of the specification. It would be obvious for one of ordinary skill in the art at the time the claimed invention was made to incorporate the prior art's games in the mobile terminal of **Janninck, et al** in order to entertain the user.

Regarding claim 16, lacking any critically, making prior art parts separable does not make the claimed invention over that prior art, *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gray disclose a portable telephone made short enough and flat enough to be conveniently carried upon the person, yet allowing it to be quickly reconfigured into a form that is long enough and contoured enough to be effective and natural to use. The telephone chassis includes a pair of chassis sections which are interconnected by a pivot connection about which the chassis sections are rotated between open or closed positions. The pivot connection defines a pivot axis and a plane of rotation which are oriented in angulated relation with both chassis sections so that the chassis sections define a compact configuration when closed and an ergonomic configuration when rotated to the

open position. A manually releasable spring urged locking mechanism is provided to lock the chassis sections against relative rotation at both the open and closed positions. A torsion spring is provided to partially open or partially close the chassis sections upon manual unlocking thereof and to permit free rotation during predetermined relative pivotal movement of the chassis sections. A mechanism may also be provided for automatic extension and retraction of an antenna which is actuated by opening and closing movement of the telephone chassis sections.

Jambhekar shows a transformable hinge (130) foldably connects two substrates (110, 120) at curved mating edges (140, 150). The transformable hinge (130) is capable of folding between a closed position for storage and an open position for use. In the open position, the transformable hinge (130) exhibits a configuration which orients an audio transducer (320) for communication of sound with the user's head when in the open position. Radiotelephone circuitry can be part of one substrate (110) and accessories can be received by the other of the substrates (120).

Shindo teaches a portable information terminal includes a body casing which incorporates a function unit for transmitting and receiving information and has a groove portion with a plane bottom, and a card casing which is reversibly and slidably attached in the plane-bottom groove portion of the body casing and has an operation unit. The plane-bottom groove portion of the body casing has a rectangular shape with side surfaces opposed to each other and a pair of guide

grooves are formed on the opposed surfaces thereof. The card casing has a rectangular shape substantially similar to that of the plane-bottom groove portion and has a pair of pins near the end portions of the opposed side surfaces. The card casing is attached to the body casing by inserting the pair of pins into the pair of guide grooves. The body casing includes a first light emitter and a first light detector and the card casing comprises a second light emitter and a second light detector which are respectively disposed so as to be opposed to the first light emitter and the first light detector when the portable information terminal is used. The body casing includes a second operation unit on a plane portion of the plane-bottom groove portion.

Uchikura displays in a portable telephone apparatus equipped with an electronic notebook function, a telephone operation key such as a dialing key is mounted on an upper surface of an openable/closable member mounted on an upper surface of a case body, whereas electronic notebook operation keys such as a character input key are provided at a region of a surface of the case body covered by the openable/closable member, and also at a rear surface of the openable/closable member. The portable telephone apparatus further includes a switch for detecting an opening/closing state of the openable/closable member, and a mode selecting unit for selecting a telephone mode and an electronic notebook mode in response to a detection signal derived from the detecting signal. Furthermore, a search key for searching storage data about the electronic notebook is employed on this upper surface of the openable/closable member.

When this search key is operated, electronic notebook data such as telephone directory data constructed of one pair of a telephone number and a name, may be displayed on a display unit.

Harmon exhibits a mechanism and method for rotating at least a first and second housing elements (120, 220) of a device (100) with respect to one another. The first and second housing elements (120, 220) have a common axis of rotation (705), which is substantially perpendicular to a front surface of the device (100). The mechanism includes a tension device (300) having a first end coupled to the first housing element (120) and a second end coupled to the second housing element (220) at a point which travels around the axis of rotation along a path, where the path extends at least partly around the axis of rotation at a distance from the axis of rotation. The tension device (300) biases the rotational relationship of the first (120) and second (220) housing elements toward an opened position. The mechanism additionally includes a mechanical stop (600), that limits the further rotation of the first (120) and second (220) housing elements beyond an opened position. The mechanism still further includes an engagement member (400), which is engaged to one of the first and second housing elements (120, 220) and is releasably engaged with the other one of the first and second housing elements (120, 220). The mechanism maintains the first and second housing elements (120, 220) in a closed position, when the engagement member (400) is engaged with the other one of the first and second housing elements (120, 220).

Watanabe, et al disclose a wiring device is used in a folding portable device including a hinge unit permitting an upper unit to fold/unfold and/or to rotate with regard to a lower unit. The wiring device comprises a rotative direction wound portion having a first central axis corresponding to a rotating axis of the hinge. A folding/unfolding direction wound portion has a second central axis corresponding to a folding/unfolding axis of the hinge. A FPC fixing member fixes a FPC holding member holding a predetermined part of a FPC to the hinge. The rotative direction wound portion is wound with a first part of a flexible printed cable that is continuous with one end of the predetermined part. The folding/unfolding direction wound portion is wound with a second part of the flexible printed cable that is continuous with the other end of the predetermined part.

Kuo discloses a cosmetic container.

Kim, et al, Minamide, Brandenstein, and Peiker show a portable telephone.

14. Replacement Notice: Copies of Patent Application Records will be Provided in both Electronic and Paper Form

The Official Gazette notice, published on August 24, 2004 entitled "*All Electronic Copies of Patent Application Records Will Now Be Provided as Certified Copies in Electronic Form*" (1285 Off. Gaz. Pat. Off, August 24, 2004) is hereby rescinded. The USPTO is reinstating, until further notice, the procedures in effect prior to July 30, 2004 for providing certified copies of patent application records with paper certification statements. The USPTO will also offer electronic certified copies of patent application records at the requester's option.

Certified Copies with Paper Certification

Unless otherwise requested, certified copies of patent application records provided pursuant to 37 CFR 1.19 (b) will be produced with a paper certification statement, continuing the practice in effect prior to July 30, 2004. The certification statement will include an embossed seal and original signature.

Certified Copies with Electronic Certification

Customers ordering certified copies of patent applications as filed or patent-related file wrapper and contents of published applications from the USPTO website will have the option to choose electronic copies with electronic certification. These files include an imaged certification statement as part of a PDF file containing the document TIFF images. These electronic files are digitally signed by the USPTO for authenticity and integrity, and cannot be undetectably modified. Customers may choose to download these electronic files from the USPTO website or receive them on compact disc.

Paris Convention for the Protection of Industrial Property and Priority

Irrespective of whether the USPTO provides a paper certified copy or an electronic certified copy, Article 4(d)(3) of the Paris Convention prohibits any country that is a member of the convention from requiring further authentication of the certified copy for purposes of claiming priority under the Paris Convention. (The text of the Paris Convention and a list of its members are available at www.wipo.int/treaties/en/ip/paris/index.html.)

The USPTO is working with other intellectual property offices to encourage the acceptance of priority documents in electronic form with electronic certification. A list of offices and international intellectual property organizations that have agreed to accept electronic certified copies will be posted on the USPTO website soon, and updated regularly.

Questions should be directed to the Office of Public Records by email to opr@uspto.gov or by telephone at (703) 308-9743.

15. If applicants wish to request for an interview, an *"Applicant Initiated Interview Request"* form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed *"Applicant Initiated Interview Request"* form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative.

16. Consolidated Appropriations Act, 2005 enacted on December 8, 2004

H.R. 4818, the Consolidated Appropriations Act, 2005 (Consolidated Appropriations Act) was signed by President George W. Bush and enacted into law on December 8, 2004. The Consolidated Appropriations Act revises certain patent application and maintenance fees; provides separate fees for a basic filing fee, a search fee, and an examination fee; and requires an additional fee for any patent application whose specification and drawings exceed 100 sheets of paper (application size fee). The new patent fees are now effective and will remain in effect during the remainder of fiscal year 2005 and during fiscal year 2006. The patent maintenance fee changes apply to any maintenance fee payment made on or after December 8, 2004, regardless of the filing or issue date of the patent for which the fee is submitted. The revised maintenance fees took effect on December 8, 2004. Thus, any maintenance fee paid at any time on (or after) December 8, 2004 is subject to the revised maintenance fee amounts set forth in the Consolidated Appropriations Act.

Note: If you are paying via the USPTO's Internet Web site, there will likely be a delay in updating the maintenance-fee information on the USPTO's Office of Finance On-Line Shopping Web page. Therefore, if paying on-line, please refer to the updated fee schedule to ensure that you include the appropriate updated fee amount. Maintenance fees must be timely paid in the appropriate amount to avoid expiration of a patent.

The new basic filing fee (or national fee), search fee, examination fee, and application size fee apply to national patent applications (other than provisional applications) filed on or after December 8, 2004, and to international patent applications in which the basic national fee is paid on or after December 8, 2004. The new provisional application filing fee applies to any provisional application filing fee paid on or after December 8, 2004. The filing fee (or national fee), search fee, and examination fee are due on filing. If the filing fee (or national fee) is paid on filing, but the search fee and/or examination fee is missing, the USPTO will issue a notice requiring that any missing search fee and examination fee (but no surcharge until further notice) be paid within a specified period of time in order to avoid abandonment. Thus, if at least the full basic filing fee under the Consolidated Appropriations Act is paid on or after December 8, 2004, the USPTO will issue a notice requiring any balance of the search fee and the examination fee (but no surcharge).

The remaining patent application fee changes, including the excess claims fees, extension of time fees, and appeal fees, apply to any fee payment made on or after December 8, 2004, regardless of the filing date of the application for which the fee is submitted.

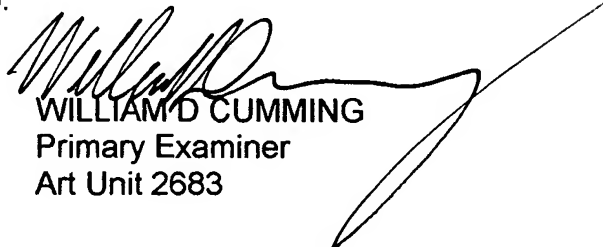
USPTO customers should monitor the USPTO's Internet Web site frequently for current patent fee information.

Payments from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D CUMMING** whose telephone number is 571-272-7861. The examiner can normally be reached on Tuesday & Wednesday, 10:30am to 8:30pm,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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Art Unit 2683

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